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EXAMINER	
FISCHER, ANDREW J	

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WALTER D. BUIST

Appeal 2008-004102
Application 10/666,817
Technology Center 3600

Decided: [1] June 29, 2009

Before, HUBERT C. LORIN, ANTON W. FETTING, and JOSEPH A. FISCHETTI, *Administrative Patent Judges*.

FISCHETTI, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

Appellant has filed a Request for Rehearing under 37 C.F.R. § 41.52(a)(3) (2007) of our Decision of December 29, 2008. In so doing, the

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[1] The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

Decision affirmed the rejection of claims 1-24 under 35 U.S.C. § 102 (b) as anticipated by Hausman.

I. Appellant argues that "...the Examiner did not rely on inherent anticipation during prosecution and in briefing the present appeal. Thus, Applicant has not had a fair opportunity to respond to the Board's inherent anticipation theory." (Req. 3). Since our reliance on inherency in affirming the rejection under 35 U.S.C. § 102 (b) "shifts the burden" to the applicant, and Appellants have not had the opportunity to rebut same, we thus modify our Decision to designate it as a new ground of rejection under 37 C.F.R. § 41.50(b).

II. Appellant next argues that that the legal standard for inherency when applied to a functional characteristic requires that the device be capable of performing the claim functions without modification. *Citing Ex Parte Kogure*, Appeal 2007-1854, 2007 WL 2698509, at *3 (Aug. 27, 2007). (Req. 3). We do not find it necessary to distinguish our Decision from *Kogure* because nothing in our Decision indicates that Hausman was modified in the manner discussed in *Kogure*. Under the principles of inherency, so long as the prior art necessarily functions in accordance with, or includes, the claimed limitations, it anticipates. *See In re King*, 801 F.2d 1324, 1326 (Fed.Cir.1986). The Decision correctly finds that

> [t]he currency translator apparatus in Hausman performs automatic calculations (FF 6) and is thus capable of being programmed to encode and interpret the values which it messages, e.g., multiply every value entered by 10 (encode) and divide the received value by 10 (interpret). (Dec. 9).

In an example given by Appellant in the Specification ¶[0031], the interpreter and encoder merely multiplies and in turn divides an order number by a multiplier other than unity (1) to arrive at a skewed meaning. In the example given, the multiplier is 10,000. Changing the multiplier in Hausman from unity (1) to, for example, 10,000, does not constitute modification of the algorithm, but rather only a change in a value used in the calculation.

Next Appellant argues that

> …the Board erred by conflating the concept of currency translation, which is described in Hausman, with the concepts of encoding and interpreting messages communicated in field delimited communication protocols to have meanings different than the standard, publicly-known protocol meaning, which is not disclosed in Hausman. (Req. 5).

We disagree with Appellant. Our Decision finds that Hausman discloses field delimited communication protocol (FIX) as set forth in our finding of facts (FF 3, 4). This was never contested by Appellant. When the encoder in Hausman receives a value from the trader either as a percentage or float for a proposal, it incorporates this value as part of the FIX communication which together gets translated into a foreign currency value. For at least these reasons, we are not convinced that Appellant has shown with particularity points believed to have been misapprehended or overlooked by the Board in rendering its earlier decision.

III. Appellant seeks to overcome our interpretation of Hausman as applied to claims 1, 7 and 13 by readily amending these claims "…to specifically claim that the encoding and interpreting steps are performed using a computing device as,

described in the specification." (Req. 7) Appellant maintains that our position regarding claims 1, 7, and 13 "...was made for the first time in the Examiner's Answer, there was no reason to make such an amendment before. However, applicant is willing to make such an amendment now." (Req. 7).

As set forth in Section I above, we have modified our Decision to designate it as a new ground of rejection under 37 C.F.R. § 41.50(b), and thus advise Appellant to use this opportunity on reopening of prosecution to remedy the claims as proposed here.

CONCLUSIONS OF LAW

We conclude:

Our decision to affirm the decision of the Examiner to reject the claims on appeal under 35 U.S.C. § 102 (e) over Hausman has not been shown to have been erroneous. Because in so affirming we used a different rationale than that articulated by the Examiner, we grant the request for rehearing only to the extent that we denominate the Decision a new ground of rejection under 37 C.F.R. § 41.50(b).

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2007).

REHEARING GRANTED AS TO DEMONINATING A NEW GROUND UNDER 37 C.F.R. § 41.50(b)

Appeal 2008-004102
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